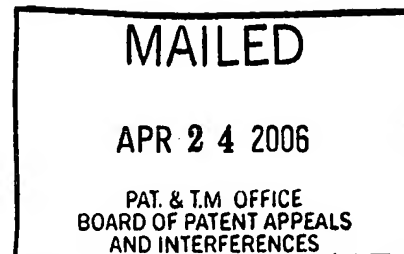


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCE



Ex parte ROBERT SIXTO JR. and JUERGEN A. KORTENBACH

Application 10/010,246

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on April 4, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing are identified below.

Information Disclosure Statement

An Information Disclosure Statement (IDS) were filed June 29, 2005. It is not clear from the record whether the examiner considered the IDS or whether the examiner notified appellant of why their submission did not meet the criteria set forth in 37 CFR § 1.97 and 1.98.

Appeal Brief

A review of the file indicates that on June 8, 2005, appellants filed an Appeal Brief under the rules et forth in 37 CFR § 41.37(c). However, the Appeal Brief filed on June 8, 2005, does not fully comply with the new rules under 37 CFR § 41.37(c).

37 CFR § 41.37 states in part:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(I) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(I) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

(ix) **Evidence appendix.** An appendix containing copies of any evidence submitted pursuant to §§ 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

(x) **Related proceedings appendix.** An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

An in-depth review of the Appeal Brief indicates that the following sections are missing from the Appeal Brief filed June 8, 2005:

1) "Evidence Appendix," as set forth in 37 CFR § 41.37(c)(1)(ix); and

2) "Related Proceedings Appendix," as set forth in 37 CFR § 41.37(c)(1)(x).

It is required that a supplemental Appeal Brief be submitted that is in compliance with 37 CFR § 41.37(c). For more information on the Board's new rules, please see the web page entitled "More Information on the Rules of Practice Before the BPAI," Final Rule at:

<http://www.uspto.gov/web/offices/dcom/bpai/fr2004/moreinfo.html>.

Examiner Answer

The Examiner's Answer mailed August 23, 2005, is not in compliance with the requirements of 37 CFR § 41.37. The Examiner's Answer mailed August 23, 2005 contains a new grounds of rejection. The rules states that an Examiner's Answer containing new grounds of rejection must be signed by a Group Director.

Application 10/010,246

A revised Examiner's Answer that is in compliance with 37 CFR § 41.37 is required.

Reply Brief

On October 25, 2005, appellants filed a Reply Brief in response to the Examiner's Answer mailed on August 23, 2005. However, there is no indication on the record that the Reply Brief was considered by the examiner.

Accordingly, it is

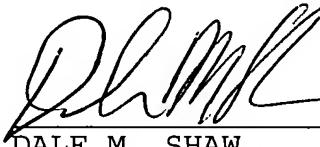
ORDERED that the application is return to the Examiner to:

- 1) consider the Information Disclosure Statements filed June 29, 2005;
- 2) provide appropriate written notification by the examiner to appellants for such consideration;
- 3) have a copy of the consideration of the information Disclosure Statements scanned into the record;
- 4) hold the Appeal Brief file on June 8, 2005 defective;
- 5) notify appellants to file a supplemental Appeal brief in compliance with 37 CFR § 41.37 or form the examiner to present a statement regarding the position taken on the missing appendices;
- 6) to vacate the Examiner's Answer mailed August 23, 2005, and submit a revised Examiner's Answer in accordance with the new rules effective September 13, 2004;

Application 08/994,363

- 7) to consider the Reply Brief;
- 8) send a written notification to appellants of said consideration; and
- 9) for such action as may be appropriate

BOARD OF PATENT APPEALS
AND INTERFERENCE

A handwritten signature in black ink, appearing to read 'DMS', with a long horizontal line extending to the right.

DALE M. SHAW
Program and Resource Administrator
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DMS/pgc

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